

In the Office Action Summary, the Examiner again indicates an objection to the drawings filed on February 4, 2000, but does not provide adequate clarification to enable Applicants to correct/address the objection. It is acknowledged that the drawings are informal, but no PTO Form 948 has been received and the Examiner has not stated a reason for the objection. Please provide additional information so that the objection(s) may be resolved.

Claims 1-3, 9-12, 16-19, 25-28 and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Nukui in view of Hecht. Reconsideration of the rejection is respectfully requested.

According to the Examiner, Nukui allegedly teaches:

a data symbol reading device for reading a data symbol, having an indication section which notifies the device user of a positioning condition of the device relative to a symbol reading area of the data symbol on a surface. The device also features an operation switch, two light sources, and a charge coupled device.

(May 8, 2002 Official Action at page 3.) (Nukui references removed.) The Examiner admits that Nukui fails to specifically teach coded embedded data, and she cites Hecht for disclosing these features. The Examiner further alleges that:

[o]ne of ordinary skill in the art would have readily recognized that a glyph code may store a large amount of data that is hidden and is undetectable with the unaided eye, thereby causing dishonest and unauthorized decoding of the code more difficult. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Nukui with the coded embedded data as taught by Hecht.

(Id. at page 3.) The Examiner next admits that Hukui/Hecht lack the teaching of data related to the orientation of the substrate, and she cites U.S. Patent No. 5,725,253 to Salive et al. To support the combination, the Examiner alleges that:

[o]ne of ordinary skill in the art would have readily recognized that capturing data related to the orientation of the substrate would have been beneficial to the invention of Nukui/Hecht since it would have provided a means for possibly discovering whether the substrate is properly positioned.

(Id. at page 4.) For the reasons stated below, Applicants disagree with the Examiner's rejections and respectfully requests reconsideration of this application in light of these remarks, and allowance of the claims.

The present invention as recited in amended independent claims 1 and 17 is directed to an apparatus and method for capturing information from a substrate using an apparatus having a viewing area for assisting a user in positioning the apparatus over a particular area of the substrate, comprising: positioning the apparatus over a particular area of the substrate using the viewing area; and capturing coded embedded data from the surface of the substrate, said embedded data including an orientation of the substrate and a location of the coded embedded data on the substrate.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001).) Second, a reasonable expectation of success must exist. Third, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).) In this case, the cited references fail to teach or suggest all the claim limitations. Even assuming the combination of

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Salive with Nukui/Hecht is proper, it still does not reach the teachings of the present invention as recited in independent claims 1 and 17 since none of the cited references disclose the capability to capture coded embedded data from the surface of the substrate, said embedded data including an orientation of the substrate and a location of the coded embedded data on the substrate.

According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Nukui/Hecht with the aforementioned teachings of Salive. Applicants disagree. More specifically, none of the cited references disclose the capability to capture coded embedded data from the surface of the substrate, said embedded data including an orientation of the substrate and a location of the coded embedded data on the substrate. One embodiment of Salive teaches that:

the circular encoded labels are used in identifying objects during or after handling, such as the ends of rods, pipes, bottles or logs which have no normal single positional (rotational) orientation. A cradle 201 bears identifying visual or wireless sensing indicia such as bar codes or radio identification tags 203 in order to locate the whereabouts of the items at the time of recording.

(Salive at col. 4, lines 48-51.) In essence, Salive teaches that the location of the coded embedded data is retrieved from a second source, not the substrate itself as claimed in the present invention. Therefore, the rejection of independent claims 1 and 17 under 35 U.S.C. § 103(a) as unpatentable over Salive and Nukui/Hecht should be withdrawn. The rejection of dependent claims 2-3, 9-12, 16, 18-19, 25-28 and 32 should also be withdrawn as they depend on allowable subject matter as recited in the respective independent claims from which they directly or indirectly depend.

The Examiner also rejects claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) as unpatentable over Nukui-Hecht/Salive as applied to claim 1, and further in view of U.S. Patent

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No. 5,513,264 to Wang. According to the Examiner, Nukui-Hecht/Salive "lack the teaching of a viewing area comprising a display for displaying an image based on the coded embedded data" and she cites Wang for allegedly teaching this feature. For the same reasons articulated above, Applicants respectfully submit that the withdrawal of the rejection of claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) is in order as they depend from allowable base claims.

In view of the foregoing, it is submitted that the cited prior art considered separately or in combination fails to teach or suggest the Applicants' invention. Therefore, it is respectfully asserted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, he is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-32 in condition for allowance. Applicants submit that the proposed amendments to claims 1 and 17 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner continue to dispute the patentability of the pending claims.

Applicants, therefore, request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

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If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, and not requested by attachment, such extension is hereby requested. If there are any fees due under 37 C.F.R. § 1.16 or 1.17 that are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge those fees to Xerox Deposit Account No. 24-0037.

Respectfully submitted,

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